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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/620,139 | 07/14/2003 | Eric Unger Eskey | 10014489-4 | 8466 |

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P. O. Box 272400
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EXAMINER

PELHAM, JOSEPH MOORE

| | |
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| ART UNIT | PAPER NUMBER |
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3742

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/620,139

Applicant(s)

ESKEY, ERIC UNGER

Examiner

Joseph M Pelham

Art Unit

3742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-43 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 33-43 is/are allowed.
- 6) ☒ Claim(s) 23-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

Claim Rejections - 35 USC § 112

Claims 23-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 23 recites only a "machine" in which a hidden light source is used to illuminate a visible display. While the Examiner appreciates the imperative of claim breadth commensurate in scope with the broadest enabling disclosure, for one of ordinary skill, in this case the invention of claim 1 would, if patented, be infringed by anything from a passenger jet to battery powered toy robot, if only an illuminated user display is not immediately proximate its light source. Hence the claim scope includes subject matter of which only a small fraction is enabled by the disclosure, and implicates a field of search which is nearly limitless.

Claim Rejections - 35 USC § 102

Claims 23, 25, 26, 30, and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. 4616291 to Sarnecki et al.

Referring to Fig. 1, Sarnecki et al discloses the invention as claimed, including a "non-perceivable light source" (26), reflective surfaces (32) constituting with element 28 a "light pipe" which conveys light to a "perceivable" "translucent component" (23) serving a "user interface."

Claim Rejections - 35 USC § 103

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sarnezki et al in view of Japanese Patent document 11-84921 to Fukao et al

The claims differ from Sarnezki et al only in calling for fiber optic light transmission means. However, Fukao et al shows that fiber optic transmission means are known for the purpose of conveying light from a hidden, internal source to other device locations. It would have been obvious to utilize the fiber optic means of Fukao et al in the device of Sarnezki et al to allow more convenient relative placement and compactness of the light source and the illuminated component assembly, since fiber optic means may be arranged in virtually any configuration.


Allowable Subject Matter

Claims 33-43 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph M Pelham whose telephone number is 703-308-1709. The examiner can normally be reached on M-F 7:30 AM to 4:00 PM.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



J. Pelham
AU 3742